

## REMARKS

Claims 1, 2, 4, 6, 7, 16, 22, and 45-48 are pending in the application.

Claims 1, 2, 4, 6, 7, 16, 22, and 45-48 stand rejected.

Claims 1, 16, 22, and 47 stand rejected under 35 U.S.C. § 103(a).

Claims 2, 4, 6, 7, 45, 46, 47, and 48 stand rejected under 35 U.S.C. § 103(a).

### *Double Patenting*

In light of the amendments to the claims, the Applicant respectfully requests that the Examiner revisit whether the claims are still properly rejected as double-patented over U.S. Patent Nos. 6,269,348, 5870723, and 5838812. If necessary, the Applicant is prepared to submit a terminal disclaimer to overcome the double-patenting rejection when the claims are otherwise allowable.

### *Specification*

The Applicant updates the cross section part of the specification at page 1, line 9 to reflect that US application serial number 09/244,784 is now US Patent No. 6,012,039.

### *Defective Rejection*

The Examiner cites US Patent No. 6,496,107 to Himmelstein ("Himmelstein") in a 35 U.S.C. § 103(a) rejection with respect to claims 2, 4, 6, 7, 45, 46, 47, and 48. However, Himmelstein is not prior art with respect to these claims. Thus, the rejection is defective.

Himmelstein claims priority from provisional application No. 60/145,378, filed on July 23, 1999, and from provisional application No. 60/147,057, filed on August 3, 1999. The present application is a continuation of US application serial number 09/244,784 filed February 5, 1999, now US Patent No. 6,012,039. The subject matter of claims 2, 4, 6, 7, 45, 46, 47, and 48 predates the Himmelstein reference. For example, claim 2 is supported by at least column 14, lines 26-27 and 32-35 of US Patent No. 6,012,039, which as previously mentioned, is part of the priority chain of references for the present application; claim 4 is supported by at least column 14, lines 19-20; claim 6 is supported by at least column 6, lines 46-48, column 9, line 44 to column 10, line 11, and FIG. 3; claim 7 is supported by at least column 10, lines 44-60; claim 45 is supported by at least column 13, line 65 to column 14, line 6; and claims 46-48 are supported

by at least column 6, lines 46-48, column 9, line 44 to column 10, line 11, and FIG. 3. Therefore, the Applicant requests removal of the 35 U.S.C. § 103(a) rejection and submits that claims 2, 4, 6, 7, 45, 46, 47, and 48 are in proper form for allowance.

### ***Claim Rejections - 35 U.S.C. § 103***

Claims 1, 16, 22, and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 5,546,471 to Merjanian (“Merjanian”). The Applicant respectfully traverses the rejection.

The Applicant submits that Merjanian fails to teach the concept of a “scrip beneficiary”, which is a concept that is distinct from the “scrip donor” and “scrip supporter” elements of claim 1. In the Final Office Action, the Examiner explained why he thought Merjanian taught the features of the claims (scrip supporter, scrip donor, and scrip beneficiary). Specifically, the Examiner asserted, on the top of page 6 of the Final Office Action, that Merjanian discloses all participants of the Medicaid embodiment as follows:

- the scrip supporter is the patient who uses a Medicaid benefit,
- the scrip donor is the Medicaid agency, and
- the scrip beneficiary is the health care provider rendering the service.

But this accounting requires the “beneficiary” to be the health care provider, a concept that is contrary and backward from the idea that scrip transactions benefit and support the beneficiary. In fact, in a Medicaid transaction, the person who is benefiting from the transaction is the patient: the party the Examiner analogized to the “scrip supporter.” In other words, the Examiner is attempting to read the scrip limitations into Merjanian’s Medicaid embodiment, resulting in a failed analogy that demonstrates shortcomings of this reference to anticipate or make obvious the applicant’s claims.

Nevertheless, in the interest of furthering prosecution, the Applicant amends claim 1 to set forth: “upon successful comparison, settling a scrip transaction by debiting an account of a scrip donor identified by the scrip donor identification information and making a donation to an account of a scrip beneficiary responsive to the amount debited.” This amendment is supported by at least page 2, lines 18-28 of the specification. If the scrip beneficiary is the health care provider (which the Applicant respectfully disputes), then a donation is not made to the account of the scrip beneficiary, as set forth in amended claim 1. Rather, a payment is made to

the health care provider's account for services rendered to the patient. Thus, Merjanian fails to teach each of the limitations of claim 1. Claims 2, 4, 6, 7, 16, 22, and 45-48 depend from amended claim 1. Based at least on this on this dependency, and on their own merits, these claims are allowable.

### *New Claims*

Claim 49 is directed toward the method of claim 1, wherein making the donation further includes automatically making the donation to the account of the scrip beneficiary responsive to a predefined percentage of purchases transacted by the scrip supporter.

Claim 50 is directed toward the method of claim 49, wherein the scrip beneficiary is at least one of a non-profit entity, a public school, a charity, a church, and a civic organization.

Claim 51 is directed toward the method of claim 49, further comprising electronically tracking the automatic scrip donation to the scrip beneficiary so that the scrip supporter can report the donation as a tax deduction.

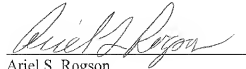
One of the problems of the prior art relates to the inconvenient and insecure methods for carrying out scrip transactions. Embodiments of the present application address these disadvantages by making scrip transactions electronic, tokenless and biometric-based so that such transactions are less cumbersome, more spontaneous, and highly secure (*see* specification, page 10, lines 20-23). This is especially useful for facilitating scrip donations to non-profit and charity organizations, as explained throughout the specification. Accordingly, claims 49-51 have been added to recite certain features with respect to making scrip donations. Based at least on their dependency from claim 1, and on their own merits, claims 49-51 are in proper form for allowance.

Reconsideration is requested. The rejections are traversed. No new matter is added. Claim 1 is amended. Claims 49-51 are added. Claims 1, 2, 4, 6, 7, 16, 22, and 45-51 remain in the case for consideration.

For the foregoing reasons, reconsideration and allowance of claims 1, 2, 4, 6, 7, 16, 22, and 45-51 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in cursive script, appearing to read 'Ariel S. Rogson', is written over a horizontal line.

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